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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,808	12/02/2003	Luis Elenes	200309860-1	4114

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EXAMINER

SEVERSON, JEREMY R

ART UNIT	PAPER NUMBER
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3653

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/726,808

Applicant(s)

ELENES, LUIS

Examiner

Jeremy R. Severson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-10, 13, 15-23 and 25 is/are rejected.
- 7) ☒ Claim(s) 2, 5, 14 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Japanese Pat. No. 5-24676.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The 35 USC 112 rejections are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujioka (Jap. Pat. No. 5-24676, 1993).

Re claim 1, Fujioka discloses a method of processing sheet media, comprising: moving a sheet medium upward by contact of a face of the sheet medium with a roller 116B rotating about an axis of rotation (fig. 9); and carrying a trailing edge of the sheet medium upward and then over the roller with a member 116C (fig. 14), wherein the member is connected to the roller such that the member completely orbits the axis of rotation along a circular path, wherein the member has a distal tip that is spaced farthest from the axis of rotation, and wherein the member extends away from the axis of rotation to the distal tip along a nonlinear path.

Re claim 3, Fujioka discloses the method of claim 1, wherein the carrying includes engaging the trailing edge with the member. See fig. 12)

Re claim 4, Fujioka discloses the method of claim 1, wherein the carrying a trailing edge further comprises carrying the trailing edge of the sheet medium through about 90 to about 180 degrees of a circular path. See figs. 9-15.

Claims 13, 17-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (US 5,215,394).

Re claim 13, Kim discloses a media processing apparatus, comprising: a rotatable member 20b; and a resilient member 20b having convex and concave sides (see fig. 6B) connected to the rotatable member and configured to engage a trailing edge of a sheet medium and lift the trailing edge upward and over the rotatable member as the rotatable member rotates, wherein the rotatable member is configured to rotate in a direction, and wherein the at least one resilient member is configured to bend opposite to the direction and toward the concave side upon contact with a face of the sheet medium wherein the at least one resilient member is configured to have a retracted position (fig. 6A) and an extended position (fig. 6C), wherein the at least one resilient member is configured to be placed in the retracted position by contact with a face of the sheet medium and to return to the extended position when the contact is removed, wherein the rotatable member defines a radius, and wherein the at least one

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resilient member includes a distal portion configured to be disposed inside the radius in the retracted position and outside the radius in the extended position.

Re claim 17, Kim discloses the apparatus of claim 13, wherein the at least one resilient member includes a plurality of spaced resilient members.

Re claim 18, Kim discloses the apparatus of claim 13, further comprising a colorant application mechanism 9 configured to apply a colorant to the sheet medium.

Re claim 19, Kim discloses the apparatus of claim 18, further comprising an output site for receiving printed sheet media, and wherein the at least one resilient member is configured to lift the sheet medium over the rotatable member to enable the trailing edge of the sheet medium to reach the output site.

Re claim 20, Kim discloses the apparatus of claim 13, wherein the resilient member is connected integrally to the rotatable member.

Re claim 21, Kim discloses an apparatus for displacing a sheet of print medium from a direction of movement of the print medium produced by a roller, comprising: a body configured to be connected to the roller for rotation therewith; and at least one resilient finger connected to the body and configured to be deflected toward the body via bending in a predefined region of the at least one resilient finger, and generally away from the direction of movement, by contact with a face of the print medium to permit movement of the medium along the path and also being configured to engage a trailing edge of the print medium to carry the trailing edge away from the path as the resilient finger rotates, wherein the at least one resilient finger includes a proximal portion that

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extends radially from the roller and a distal portion that extends non-radially from the body.

Re claim 22, Kim discloses the apparatus of claim 21, wherein the body and the resilient finger are formed as a single piece from an elastomeric material.

Re claim 25, Kim discloses the apparatus of claim 21, wherein the at least one resilient finger includes a distal portion spaced from the body, and wherein the distal portion includes a substantially planar surface configured to contact the face of the sheet in the retracted position.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka.

Re claim 6, Fujioka comprises everything except the step of placing colorant on the sheet medium before the carrying. It would have been obvious to one of ordinary skill in the art at the time of the invention to print on the sheets before carrying them by the roller of Fujioka, because it is well-known in the art that one can feed printed sheets before feeding them with rollers.

Re claim 7, Fujioka discloses a method comprising: moving the sheet medium along an upward path after the placing; and carrying a trailing edge of the sheet medium along an arcuate path extending upward with a roller defining an axis of rotation and having a protrusion that includes a radially-extending base and a non-radially extending tip; the protrusion orbiting the axis of rotation along a circular path as the roller rotates.

Re claim 8, Fujioka discloses the method of claim 7, wherein the carrying a trailing edge further comprises carrying the trailing edge of the sheet medium along an arcuate path extending upward and then downward.

Re claim 9, Fujioka discloses the method of claim 7, wherein the moving is performed by the protrusion that contacts a face of the sheet medium.

Re claim 10, Fujioka discloses the method of claim 7, wherein the carrying a trailing edge further comprises carrying the trailing edge of the sheet medium through an angle of about 90 to about 180 degrees.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim.

Re claim 23, Kim discloses the apparatus of claim 21. Kim further indicates that there can be "one or more" resilient fingers (col. 3, lines 35 et seq.), but does not explicitly indicate that the at least one resilient finger is a plurality of at least three resilient fingers. It would have been obvious to a person of ordinary skill in the art to use three resilient fingers, based on the teaching of "one or more" resilient fingers in Kim.

Allowable Subject Matter

Claims 2, 5, 14 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

- claim 2 includes the step of deflecting the member, which is not taught in the nearest prior art (e.g., Fujioka);
- claim 5 includes a step not taught by the nearest prior art (e.g., Fujioka); and
- claims 14 and 24 includes a thinned region that is not found in the nearest prior art (e.g., Kim).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Please note that subject matter that had been indicated as allowable in a prior Office Action is now rejected. Therefore, this Office Action is non-final.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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- Mochizuki (US 4,870,258) teaches a roller with a thinned region. See e.g., fig. 38. However, the Examiner has determined that the teachings of Mochizuki do not render claim 14 obvious in light of the knowledge of a person of ordinary skill in the art at the time of Applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Severson whose telephone number is (571) 272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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